IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Richard G. Sevier   **CONFIRMATION NO:** 3095

SERIAL NO.: 10/700,215   **GROUP ART UNIT:** 2609

FILED: November 3, 2003   **EXAMINER:** Storey, William C

SUBJECT: SELECTING A DIGITAL IMAGE

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THE COMMISSIONER OF PATENTS
ALEXANDRIA, VA 22313-1450

APPELLANTS'/APPLICANTS' OPENING BRIEF ON APPEAL

The following is a revised appeal brief filed in response to the Notice of Non-Complaint Appeal Brief mailed November 1, 2007.

1. **REAL PARTY IN INTEREST.**

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. **RELATED APPEALS AND INTERFERENCES.**

There are no other appeals or interferences known to Appellants, Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. **STATUS OF CLAIMS.**

Claims 1, 4-10, 20, 23-29, 39 and 50 are pending but stand rejected. Claims 2, 3, 11-19, 21, 22, 30-38, and 40-49 have been cancelled. All pending claims are appealed.

4. **STATUS OF AMENDMENTS.**

Following entry of the final rejection, Claims 1 and 20 and paragraph [0041.1] were amended to correct typographical errors. All other previous amendments have been entered.

5. **SUMMARY OF CLAIMED SUBJECT MATTER.**

Claim 1 recites a digital image selection method that includes obtaining a first digital image of a first side of a physical object. *See, e.g.,* Specification , paragraph [0039], page 9, lines 17-24. That physical object is a first of an ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The first digital object is examined to determine if it is substantially blank. *See, e.g.,* Specification ,

paragraph [0039], page 9, lines 17-24. If the first digital image is not substantially blank, a first set of digital images is obtained. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the first set is a digital image of a first side of a physical object of the ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The first set of digital images is then sent for processing. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). If the first digital image is substantially blank, a second set of digital images is obtained. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the second set is a digital image of a second side of a physical object of the ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The second set is then sent for processing. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number).

Claim 20 recites a computer readable medium having instructions for implementing a method that includes obtaining a first digital image of a first side of a physical object. *See, e.g.,* Specification , paragraph [0039], page 9, lines 17-24. That physical object is a first of an ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The first digital object is examined to determine if it is substantially blank. *See, e.g.,* Specification , paragraph [0039], page 9, lines 17-24. If the first digital image is not substantially blank, a first set of digital images is obtained. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the first set is a digital image of a first side of a physical object of the ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The first set of digital

images is then sent for processing. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). If the first digital image is substantially blank, a second set of digital images is obtained. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the second set is a digital image of a second side of a physical object of the ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The second set is then sent for processing. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number).

Claim 39 recites a system for digital image selection. The system includes an image manager and a content module. *See, e.g.,* Specification, paragraph [0024], page 5, lines 18-32 and Fig. 3. The image manager is operable to obtain a first digital image of a first side of a physical object and a second digital image of a second side of the physical object. *See, e.g.,* Specification, paragraph [0027], page 6, lines 15-24. The content module operable to examine the first digital image to determine if it is substantially blank. *See, e.g.,* Specification, paragraph [0024]-[0025], page 5, line 18 through page 6, line 10. The image manager is further operable to send the second digital image for processing if the first digital image is substantially blank and to send the first digital image for processing if the first digital image is not substantially blank. *See, e.g.,* Specification, paragraph [0027]-[0028], page 6, line 15 through page 7, line 2. The physical object is a first of an ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The image manager is further operable to, if the first digital image is determined to not be substantially blank, obtain a first set of digital images. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this

paragraph was added by amendment so it cannot be referenced by page and line number). The image manger then sends the first set of digital images for processing. The image manager is further operable to, if the first digital image is determined to be substantially blank, obtain a second set of digital images. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The image manager then sends the second set of digital images for processing. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number).

Claim 50 recites a system for digital image selection. The system includes various means for performing various functions. Included are a means for obtaining a first digital image of a first side of a physical object and a second digital image of a second side of the physical object. *See, e.g.,* Specification, paragraph [0027], page 6, lines 15-24. The system includes a means for examining the first digital image to determine if it is substantially blank. *See, e.g.,* Specification, paragraph [0024]-[0025], page 5, line 18 through page 6, line 10. The system includes a means for, if the first digital image is not substantially blank, obtaining a first set of digital images and sending the first set of digital images for processing. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the first set is a digital image of a first side of a physical object of the ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The system also includes a means for, if the first digital image is substantially blank, obtaining a second set of digital images and sending the second set of digital images for processing. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the second set is a digital image of a second

side of a physical object of the ordered set of physical objects. *See, e.g.,* Specification , paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number).

6. GROUNDS FOR REJECTION TO BE REVIEWED.

A. Claims 1-16 stand rejected under 35 USC §102 as being anticipated by US Pub 2003/0184782 to Perkins.

B. Claims 4, 23, and 24 stand rejected under 35 U.S.C. 103 as being unpatentable over US Pub 2005/0200903 to Okubo in view of Japanese Publication 05-048835 to Furumura.

C. Claims 9 and 28 stand rejected under 35 U.S.C. 103 as being unpatentable over US Pub 2005/0200903 to Okubo in view of US Pub 2003/0048470 to Garcia

D. Claims 10 and 29 stand rejected under 35 U.S.C. 103 as being unpatentable over US Pub 2005/0200903 to Okubo in view of US Pub 2004/0145770 to Nakano.

7. ARGUMENT.

Grounds For Rejection A – Claims 1, 5-8, 20, 25-27, 39 and 50 stand rejected under 35 U.S.C. 102(e) as being anticipated by US Pub 2005/0200903 to Okubo.

A §102 rejection of a claim is only proper when each and every element as set forth in the claim is found, expressly or inherently, in a single prior art reference.

Claim 1 is directed to a digital image selection method and as, as amended, recites the following:

1. obtaining a first digital image of a first side of a physical object, the

2.   examining the first digital image to determine if it is substantially blank;

3.   if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects and, sending the first set of digital images for processing; and

4.   if the first digital image is substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and sending the second set of digital images for processing.

physical object being a first of an ordered set of physical objects;

To summarize, a digital image of a first side of an initial page of a set of pages is obtained. It is determined if that digital image is blank. If blank, digital images of the second sides of set of pages are obtained and sent for processing. If not blank, digital images of the first sides of set of pages are obtained and sent for processing.

Okubo describes scanning a series of pages to form image data. Okubo, Fig. 3, step S11. After the image data is obtained, a determining unit 14 determines characteristics of each page image data. Okubo, paragraph [0034]. Based on this determination, an optimizing unit eliminates pages judged to be blank. Okubo, paragraph [0035]. In a response mailed December 19, 2007, The Appellant explained that Okubo mentions nothing of first obtaining digital images for a selected first of second sides of a set of pages where the particular side is selected based upon whether or not the first side of an initial page is substantially blank. Consequently, Okubo fails to teach the third and fourth limitations of Claim 1 listed above.

At page 4 of the office action mailed February 20, 2008, the Examiner responded stating the following:

Further, Okubo discloses "the optimizing unit 15 optimizes the image data and sends the optimized image data to the compressing unit 16 and data output unit," as disclosed at Figure 1 and paragraph 35. In addition, Okubo discloses "the determining unit 14 determines on a page-by-page basis whether or not data is image data," which reads on claimed if the "if

the digital image of the first set is not substantially blank" and "if the first digital image is substantially. blank," as disclosed in paragraph 27. If the "set" is a set of 1, then this and the previous disclosures read on "sending the second digital image for processing if the first digital image is substantially blank; and sending the first digital image for processing if the first digital image is not substantially blank." For example, if the front side of a piece of paper (set) is blank, the opposite side of the set of 1 is sent. If the front side isn't blank, the front side of the set of 1 will be sent.

To summarize, the Examiner asserts Okuba reads on Claim 1 **IF** "the 'set' is a set of 1." The Appellant respectfully argues that this is an unreasonably broad interpretation of Claim 1.

Claim 1 expressly recites obtaining a first digital image of a first side of a physical object and that the physical object is a first of an ordered set of physical objects. The term objects is plural meaning more than one. In other words, the physical object has multiple sides and is one of a set or plurality of such objects. Paragraph [0028] of the Specification distinguishes a single physical object from and ordered set of physical objects. In particular, paragraph [0028] states:

A digital image can be obtained in any number of ways. For example, a surface of a physical object such as a side of a sheet of paper can be scanned to obtain a first digital image. The opposing side can be scanned to obtain a second digital image. A set of digital images can be obtained by sequentially scanning an ordered set of pages. A first set can be obtained by scanning the first side of each of the pages. A second set can be obtained by scanning the second side of each of the pages.

In paragraph 28 each two sided page is a physical object. Plainly, the ordered set of pages includes a plurality of pages so that a first set of images can be obtained from the first side of each of the pages and a second set of images can be obtained from the second sides. Paragraph [0028] distinguishes this from simply obtaining images from each side of a single page.

Furthermore, Merriam-Webster unabridged online edition defines the term "set" (as used in the Specification and Claims) as follows:

a group of articles of uniform design <*set* of dining room furniture> <*set* of dishes> b : the complete apparatus or equipment used in a particular process (as gas manufacture) c : an assortment of tools or instruments of identical kind <*set* of drill bits in graded sizes> or complementary relationship <*set* of drafting tools> <*set* of carpenter's tools> <*set* of golf clubs> d : a complete collection of articles necessary for playing a game <croquet *set*> <chess *set*> e *Britain* : a string of railway cars of the same exterior style f : a group of pumps that are used for lifting water from one level to another g : a group comprising breaker, intermediate, and finisher cards used in wool carding.

See http://unabridged.merriam-webster.com. The abridged version defines "set" as "a number of things of the same kind that belong or are used together." *See* http://www.merriam-webster.com/dictionary. Each definition requires the set to include multiple objects. It would not be proper to say that a single article has a uniform design with itself. Moreover a single "thing" could not properly be considered a number of things that belong or are used together. By its very nature, the term "set" as used in the Specification and Claims requires a plurality of articles – in this case – a plurality of physical objects.

Consequently, an ordered set of physical objects as recited by Claim 1 includes a plurality of such physical objects. While the Examiner is required to broadly interpret a claim, that interpretation must still be reasonable. The Examiner's interpretation that an ordered set of physical objects can be a set of one such physical object is NOT reasonable.

As such, Okubo fails to teach or suggest the first third, third and fourth elements of Claim 1 listed above. For at least this reason, Claim 1 is patentable over Okubo as are Claims 4-10 which depend from Claim 1.

Claim 20 is directed to a computer readable medium having instructions for implementing the method of Claim 1. For at least the same reasons Claim 1 is patentable, so are Claim 20 and Claims 23-29 which depend from Claim 20.

Claim 39 is directed to a system having various components configured to implement the method of Claim 1. For at least the same reasons Claim 1 is patentable, so is Claim 39.

Claim 50 is directed to a system having various means for implementing the method of Claim 1. For at least the same reasons Claim 1 is patentable, so is Claim 50.

Grounds For Rejection B – Claims 4, 23, and 24 stand rejected under 35 U.S.C. 103 as being unpatentable over US Pub 2005/0200903 to Okubo in view of Japanese Publication 05-048835 to Furumura.

Claim 4 depends from Claim 1 while Claims 23 and 24 depend from Claim 20. For at least the same reasons Claims 1 and 20 are patentable, so are Claims 4, 23, and 24

Grounds For Rejection C – Claims 9 and 28 stand rejected under 35 U.S.C. 103 as being unpatentable over US Pub 2005/0200903 to Okubo in view of US Pub 2003/0048470 to Garcia

Claim 9 depends from Claim 1 while Claim 28 depends from Claim 20. For at least the same reasons Claims 1 and 20 are patentable, so are Claims 9 and 28.

Grounds For Rejection D – Claims 10 and 29 stand rejected under 35 U.S.C. 103 as being unpatentable over US Pub 2005/0200903 to Okubo in view of US Pub 2004/0145770 to Nakano.

Claim 10 depends from Claim 1 while Claim 29 depends from Claim 20. For at least the same reasons Claims 1 and 20 are patentable, so are Claims 10 and 29.

CONCLUSION: Claims 1, 4-10, 20, 23-29, 39 and 50 are felt to be in condition for allowance. Consequently, early and favorable action reversing the rejections and instructing the Examiner to pass the application to issue is earnestly solicited.

Respectfully submitted,

Richard G. Sevier

By   /Jack H. McKinney/
     Jack H. McKinney
April 21, 2008   Reg. No. 45,685

APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. (previously presented) A digital image selection method, comprising:

obtaining a first digital image of a first side of a physical object, the physical object being a first of an ordered set of physical objects;

examining the first digital image to determine if it is substantially blank;

if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects, and sending the first set of digital images for processing; and

if the first digital image is substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and sending the second set of digital images for processing.

2. (cancelled)

3. (cancelled)

4. (previously presented) The method of Claim 1, wherein the step of examining is performed before the step of obtaining the second set of digital images and the step of obtaining the second set of digital images is performed only if the first digital image is substantially blank.

5. (original) The method of Claim 1, further comprising discarding the first digital image if it is substantially blank.

6. (previously presented) The method of Claim 1, wherein the steps of obtaining the first and second sets of digital images comprise:

scanning the first side of each physical object in the ordered set to generate the

first set of digital images; and

scanning the second side of each physical object in the ordered set to generate the second set of digital images.

7. (previously presented) The method of Claim 1, wherein:

sending the second set of digital images for processing comprises sending the second set of digital images to be printed if the first digital image is substantially blank; and

sending the first set of digital images for processing comprises sending the first set of digital images to be printed if the first digital image is not substantially blank.

8. (previously presented) The method of Claim 1, wherein:

sending the second set of digital images for processing comprises sending the second set of digital images to be incorporated in a facsimile transmission if the first digital image is substantially blank; and

sending the first set of digital images for processing comprises sending the first set of digital images to be incorporated in a facsimile transmission if the first digital image is not substantially blank.

9. (previously presented) The method of Claim 1, wherein:

sending the second set of digital images for processing comprises sending the second set of digital images to be incorporated in an electronic mail message if the first digital image is substantially blank; and

sending the first set of digital images for processing comprises sending the first set of digital images to be incorporated in an electronic mail message if the first digital image is not substantially blank.

10. (previously presented) The method of Claim 1, wherein:

sending the set of digital images image for processing comprises sending the second set of digital images to be archived if the first digital image is substantially blank; and

sending the first set of digital images for processing comprises sending the first set of digital images to be archived if the first digital image is not substantially blank.

11. (cancelled)

12. (cancelled)

13. (cancelled)

14. (cancelled)

15. (cancelled)

16. (cancelled)

17. (cancelled)

18. (cancelled)

19. (cancelled)

20. (previously presented) A computer readable medium having instructions for:

obtaining a first digital image of a first side of a physical object, the physical object being a first of an ordered set of physical objects;

examining the first digital image to determine if it is substantially blank;

if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects, and sending the first set of digital images for processing; and

if the first digital image is substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a

physical object of the ordered set of physical objects, and sending the second set of digital images for processing.

21. (cancelled)

22. (cancelled)

23. (previously presented) The medium of Claim 20, wherein the instructions obtaining the second set of digital images include instructions for obtaining the second set of digital images only if the first digital image is substantially blank.

24. (original) The medium of Claim 20, having further instructions for discarding the first digital image if it is substantially blank.

25. (previously presented) The medium of Claim 20, wherein the instructions for obtaining the first and second sets of digital images include instructions for:
scanning the first side of each physical object in the ordered set to generate the first set of digital images; and
scanning the second side of each physical object in the ordered set to generate the second set of digital images.

26. (previously presented) The medium of Claim 20, wherein the instructions for:
sending the second set of digital images for processing include instructions for sending the second set of digital images to be printed if the first digital image is substantially blank; and
sending the first set of digital images for processing include instructions for sending the first set of digital images to be printed if the first digital image is not substantially blank.

27. (previously presented) The medium of Claim 20, wherein the instructions for:
sending the second set of digital images for processing include instructions for

sending the second set of digital images to be incorporated in a facsimile transmission if the first digital image is substantially blank; and

sending the first set of digital images for processing include instructions for sending the first set of digital images to be incorporated in a facsimile transmission if the first digital image is not substantially blank.

28. (previously presented) The medium of Claim 20, wherein the instructions for:

sending the second set of digital images for processing include instructions for sending the second set of digital images to be incorporated in an electronic mail message if the first digital image is substantially blank; and

sending the first set of digital images for processing include instructions for sending the first set of digital images to be incorporated in an electronic mail message if the first digital image is not substantially blank.

29. (previously presented) The medium of Claim 20, wherein the instructions for:

sending the second set of digital images for processing include instructions for sending the second set of digital images to be archived if the first digital image is substantially blank; and

sending the first set of digital images for processing include instructions for sending the first set of digital images to be archived if the first digital image is not substantially blank.

30. (cancelled)

31. (cancelled)

32. (cancelled)

33. (cancelled)

34. (cancelled)

35. (cancelled)

36. (cancelled)

37. (cancelled)

38. (cancelled)

39. (previously presented) A system for digital image selection, comprising:

an image manager operable to obtain a first digital image of a first side of a physical object and a second digital image of a second side of the physical object;

a content module operable to examine the first digital image to determine if it is substantially blank; and

wherein the image manager is further operable to send the second digital image for processing if the first digital image is substantially blank and to send the first digital image for processing if the first digital image is not substantially blank;

wherein the physical object is a first of an ordered set of physical objects and wherein the image manager is further operable to:

if the first digital image is determined to not be substantially blank, obtain a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects, and send the first set of digital images for processing; and

if the first digital image is determined to be substantially blank, obtain a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and send the second set of digital images for processing.

40. (cancelled)

41. (cancelled)

42. (cancelled)

43. (cancelled)

44. (cancelled)

45. (cancelled)

46. (cancelled)

47. (cancelled)

48. (cancelled)

49. (cancelled)

50. (original) A system for digital image selection, comprising:

a means for obtaining a first digital image of a first side of a physical object and a second digital image of a second side of the physical object;

a means for examining the first digital image to determine if it is substantially blank; and

a means for, if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects and, sending the first set of digital images for processing; and

a means for, if the first digital image is substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and sending the second set of digital images for processing.

Evidence Appendix

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.